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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,172	07/25/2001	Oren Globberman	110/02239	7714
44909	7590	08/30/2006	EXAMINER	
WOLF, BLOCK, SCHORR & SOLIS-COHEN LLP 250 PARK AVENUE NEW YORK, NY 10177			PREBILIC, PAUL B	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/890,172

Applicant(s)

GLOBERMAN ET AL.

Examiner

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 13-15, 25, 26, 28, 29, 32, 59, 69, 72-74, 83, 85, 93, 96-103, 116-118, 212, 220, 221, 226 and 227 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/12/06</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 12, 2006 has been entered.

***Claim Objections***

Claim 119 is objected to because of the following informalities: On line 1 of claim 119, the term "comprises" does not agree with the plural subject and should be changed to --comprise---. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 232 is rejected under 35 U.S.C. 102(b) as being anticipated by Davies (GB 2,268,068). Davies anticipates the claim language where the pole as claimed is section C or D of the sleeve (4); see Figure 4 and page 8, line 26 et seq.

Claims 1-12, 16-24, 27, 30, 31, 34, 35, 37-55, 57, 58, 60-63, 66, 68, 70, 71, 78-82, 84-91, 95, 104-106, 110-112, 119-124, 148, 209, 211, 214-216, 224, 225, and 228-231 rejected under 35 U.S.C. 102(b) as being anticipated by Norman (GB-408,668).

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Norman anticipates the claim language where the language "adapted for support of two vertebral plates" is not specific enough to suggest that some minimum compression strength is required. In other words, compression strength could be for a cadaver vertebral plates in a lying down position or for a small mammal; see Figures 7-10, 17, and 27-36 as well as page 5, line 128 et seq. Compare this language to the language of claim 103 that is allowable.

With regard to claim 16, Applicant is directed to see Figures 5 and 17.

With regard to claim 63, Applicant is directed to see Figure 10 and element (47).

With regard to claims 110 to 112, the size claimed depends upon the patient size such that the claimed device of Norman reads on the claimed device.

Claims 56, 64-68, 70, 78, 84, 91-92, 94, 104, 105, 217, and 218 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonutti (US 5,707,390). Bonutti anticipates the claim language where the device of Bonutti is inherently capable of being used as a vertebral spacer in a broad sense as claimed; see Figure 25 and column 17, lines 1-22.

With regard to claim 56, the cross-sections of the extensions of Bonutti are rectangular.

With regard to claim 94, it is noted that any material of the device can be elastic including the balloon.

***Allowable Subject Matter***

Claims 13-15, 25, 26, 28, 29, 32, 59, 69, 72-74, 83, 85, 93, 96-103, 116-118, 212, 220, 221, 226, and 227 are objected to as being dependent upon a rejected base

claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***


Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Paul Prebilic  
Primary Examiner  
Art Unit 3738

**Continuation of Disposition of Claims:** Claims pending in the application are 1-32,34-74,78-106,110-112,116-124,148,209,211,212,214-218,220,221 and 224-232.

**Continuation of Disposition of Claims:** Claims rejected are 1-12,16-24,27,30,31,34,35,37-58,60-68,70,71,78-82,84,91,92,94,95,104-106,110-112,119-124,148,209,211,214-218,224,225,228-231 and 8491.